

REMARKS

Claims 16-22 are active in the present application.

At the outset, Applicants wish to thank Examiner Acquah for the helpful and courteous discussion with their undersigned Representative on September 15, 2004. During this discussion various arguments in traverse of the outstanding rejections and data to demonstrate the differences between the art and the present invention were discussed. The content of this discussion is reflected in the following comments. Reconsideration of the outstanding rejections is requested.

The rejection of Claims 16-22 under 35 U.S.C. §102(b) over Hilbert et al is respectfully traversed.

The present invention provides, in part, a process for producing a polyester resin which comprises polycondensing a dicarboxylic acid component containing terephthalic acid or its ester-forming derivative as the main component and a diol component containing ethylene glycol as the main component in the presence of (1) a compound of at least one member selected from the group consisting of titanium group elements in Group 4A of the Periodic Table, via an esterification reaction or an ester exchange reaction, wherein the above compound (1) is added to an esterification reaction tank for a final stage in a multi-stage reaction apparatus or to an esterification reaction or ester exchange reaction product in a stage for transportation to a melt polycondensation step (see Claim 16). Applicants note that Hilbert et al neither discloses, nor suggests the claimed method and, as such, cannot effect the patentability of the same.

First, Applicants direct the Examiner's attention to the fact that in one aspect of the claimed process the titanium group element (compound (1)) is added at the *final stage* of esterification. In contrast, Applicants note that Hilbert et al disclose addition of the acetyltriisopropyl titanate following esterification, but preceding polycondensation. Specifically, Applicants direct the Examiner's attention to the specification at page 24, lines 1-21, which defines the various stages of the esterification reaction, including the final stage during which the titanium group element (compound (1)) is added. In contrast, in Example 1 of Hilbert et al the esterification step is followed to completion including the final stage in which the temperature is ramped from 250°C to 265°C at a pressure of 25 psig; however, no titanium group element (compound (1)) is added during this stage. Therefore, Hilbert et al fails to read on addition of the titanium group element (compound (1)) at the claimed final stage of the multi-stage reaction apparatus.

Turning to the alternative claimed titanium group element (compound (1)) addition point, the Examiner points to Example 4 (column 17) of Hilbert et al and asserts "Ti is added prior to the melt polycondensation step." Be that as it may, on the contrary, Claim 16 of the present application defines 'Compound (1) (Group 4A of the Periodic Table) is added to an esterification tank for a final stage in multi-stage reaction apparatus or to an esterification reaction or ester exchange reaction product in a stage for transportation to a melt polycondensation step." (Claims 17 to 22 are all dependent on Claim 16) The addition time difference between Hilbert et al and the present invention may be summarized in the following table:

Item	Example 4 of <u>Hilbert et al</u>	Claim 16 of the Present Application
Addition point	Polycondensation tank	Esterification tank or stage for transportation

Moreover, the phrase “stage for transportation” in Claim 16 means that, for example, a catalyst is added to the esterification product which is present in a transportation pipe connected to a melt polycondensation tank, as exemplified at page 50, line 17 to page 51, line 15 (Example 9). Hilbert et al fail to disclose or suggest this addition point.

The standard for determining anticipation requires that the reference “must teach every element of the claim” (MPEP §2131). Therefore, in view of the foregoing, Hilbert et al cannot anticipate the claimed invention since this reference fails to disclose each and every element of Claim 16 (and, as such, dependent Claims 17-22).

Moreover, MPEP §2142 states: “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation... to modify the reference... Second, there must be a reasonable expectation of success. Finally, the prior art reference... must teach or suggest all the claim limitations.” In the present application, at no point do Hilbert et al disclose or suggest adding a titanium group element (compound (1)) to an esterification reaction tank for a final stage in a multi-stage reaction apparatus or to an esterification reaction or ester exchange reaction product in a stage for transportation to a melt polycondensation step, much less the advantages obtained thereby and exemplified in the Examples of the present application. As such, Applicants submit that Hilbert et al fail to even support a *prima facie* case of obviousness.

In view of the foregoing, Applicants request withdrawal of this ground of rejection.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

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